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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,321	09/27/1999	GUIDO M. SCHUSTER	99.365	1481

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EXAMINER
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DAVIS, TEMICA M

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 05/21/2004

33

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/406,321

Applicant(s)

SCHUSTER ET AL.

Examiner

Temica M. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>29</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Objections***

2. Claim 4 is objected to because of the following informalities: "(number)" in both occurrences should be deleted for the same reasoning used in the rejection to claim 7 in the office action mailed 11/20/2002. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by McConnell et al (McConnell), U.S. Patent No. 6,373,930.

Regarding claim 1, McConnell discloses a personal information device for controlling telephone service comprising a user interface comprising an inherent display

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as evidenced by the fact that the device is a cellular phone, PDA, computer, etc. (col. 10, lines 59-66); inherently a user input device as evidenced by the fact that the user can dial digits (col. 14, lines 8-16); a user profile having a telephone number entered by a user (i.e., the new forwarding number, col. 14, lines 8-16); a communication function to establish a data communications channel over a wireless network to a telephony control server (MSC 110) (connections of MSC 110 and mobile device 102 as shown in figure 4); the telephony control server containing the user's telephony account (i.e., database record in MSC 110) (col. 14, lines 8-16); and an update function to send a message over the data communication channel to the telephony control server, the message containing the user profile number and a request to set the user's telephony account telephone number (which reads on the call forwarding number that is to be changed) to the user profile telephone number (the message reads on the service code sent with the appended digits) (col. 14, lines 8-16).

Regarding claim 3, McConnell discloses a telephony control server (MSC 110) comprising inherently a network interface operable to provide data connectivity with a user accessible via a wireless network as evidenced by the fact the user of a wireless device can communicate with the MSC (figure 4), an accounts program to access a plurality of user accounts (database records in MSC 110) since the system provides for multiple mobile devices (figure 4, items 102, 144, etc., col. 14, lines 8-16), the accounts program operable to receive a message (service code and appended digits) to set a user telephone (new forwarding number), each user account containing a telephone number entry (call forwarding number to be changed), the accounts program being

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operable to set the telephone number in response to the message (col. 14, lines 8-16); a connection signaling function to receive a call message (i.e., call request/originating call) from the user and to establish a telephone connection between the user telephone number and a callee telephone number (dialed number) contained in the call message; and the connection signaling function operable to initiate a telephone call having at least a portion of the telephone call connected via the data network (col. 13, lines 10-55).

Regarding claim 5, McConnell discloses a method of modifying a user telephone account having a telephone number entry using a wireless personal information device (PID) connected over a data network, the method comprising the steps of updating a user profile (forwarding number) in the wireless PID to a user telephone number (new forwarding number) and sending a request (service code with appended digits) to set the user telephone account to the user telephone number over a data communications channel to a telephony control server (MSC 110) wherein the telephony control server updates the user telephone number entry to the user telephone number (col. 14, lines 8-16).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over McConnell in view of Hawkins et al (Hawkins), U.S. Patent No. 6,516,202.

Regarding claim 2, McConnell discloses the PID of claim 1 as described above and further discloses wherein a user of the PID can originate calls to another user in the system by inherently dialing digits (col. 13, lines 10-25). McConnell, however, fails to disclose the PID further comprising a contacts application operable to display a plurality of contact entries, each entry comprising a contact telephone number, the contacts application operable to send the contact telephone number over the data communications channel to the telephony control server with a message to call the contact telephone number.

In a similar field of endeavor, Hawkins discloses a mobile computer designed for wireless communication expansion. Hawkins further discloses a PID comprising a contacts application operable to display a plurality of contact entries, each entry comprising a contact telephone number (base screen 1 shown in figure 8A), the contacts application inherently operable to send the contact telephone number over a data communications channel to a telephony control server with a message to call the contact telephone number as evidenced by the fact that the call is connected via a cellular network (col. 2, lines 40-47 and col. 7, lines 18-46).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify McConnell with the teachings of Hawkins for the purpose of allowing the user to make an outgoing call to a specific person without having to dial multiple numbers, thereby allowing the user to make the phone call much faster.

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7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over McConnell in view of well known prior art.

Regarding claim 4, McConnell discloses the telephony control server of claim 3 as described above and further discloses routing an incoming/outgoing call through ports (col. 13, lines 37-43).

McConnell, however, fails to disclose a gateway locator to locate a user gateway closest to the user telephone and to locate a callee gateway closest to the callee telephone; wherein the connection signaling function initiates a portion of the call connected via the data network between the user gateway and the callee gateway.

The examiner contends, however, that at the time of invention, such a feature would have been obvious to a person of ordinary skill in the art, as such feature is well known in order to ensure that the users get the best connections for signaling (i.e., best signal strength) and best connections as far as the cost of the call.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of McConnell.

Regarding claim 6, Hawkins discloses a method for initiating a data network telephone call using a wireless PID with a display comprising the steps of starting a contacts application to display a plurality of contact entries (base screen 1; figure 8A, col. 7, lines 18-23); selecting one of the contact entries identifying a callee (col. 7, lines 36-55; base screen 1 and dialing screen 2 in figure 8A which shows that the user has selected Art from the base screen); initiating a data communications channel to a

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telephony server as evidenced by the fact the system is cellular (col. 2, lines 40-46); sending a message to call the callee (which reads on the inherent call request received before the call connection is made, col. 7, lines 36-46); connecting a telephone call to the user and the callee (col. 7, lines 36-46).

Hawkins further discloses wherein the PID can accept incoming calls (col. 7, line 64-col. 8, line 8).

Hawkins, however, fails to disclose wherein the server has a user telephone number.

McConnell discloses a cellular system wherein a user can make originating/outgoing calls to a callee (col. 13, lines 10-43) and further discloses wherein the user of the system can store a user telephone number in a telephone server (col. 14, lines 8-16).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Hawkins with the teachings of McConnell in the event that the user has forwarded all incoming calls to a different number in order to avoid missing calls.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins and McConnell as applied to claim 6 above, and further in view of well known prior art.

Regarding claim 7, the combination of Hawkins and McConnell discloses the method of claim 6 as described above. The combination, however, fails to disclose the step of connecting the telephone call to the callee by locating a callee gateway closest



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to the callee telephone and sending a signal to call the callee by dialing via a callee's central office.

The examiner contends, however, that at the time of invention, such a feature would have been obvious to a person of ordinary skill in the art, as such feature is well known in order to ensure that the users get the best connections for signaling (i.e., best signal strength) and best connections as far as the cost of the call.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Owens et al, U.S. Patent No. 6,338,140.

Humes, U.S. Patent No. 6,721,577.

Kallioniemi et al, U.S. Patent No. 6,064,887.

O,Neil et al, U.S. Patent No. 5,963,864.

Sanchez, U.S. Patent No. 6,449,479.

Fuentes, U.S. Patent No. 5,960,340.

Foladare et al, U.S. Patent No. 6,212,383.

Dennis, U.S. Patent No. 6,542,733.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-

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5837. The examiner can normally be reached Monday-Friday (alternate Fridays) from 9:00am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika Gary can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Temica M. Davis  
Examiner  
Art Unit 2681

May 10, 2004

  
**TEMICA M. DAVIS**  
**PATENT EXAMINER**